

REMARKS

In view of the above amendment, the application presently containing Claims 1 and 3-5 has been advanced to a condition for allowance.

The application stands rejected under 35 USC 132 as introducing new matter, and further stands rejected under 35 USC 102(b) as being anticipated by US Patent 5,578,375 (Okano) and US Patent 5,296, 326 (Taya). It appears that the Taya reference was inadvertently referred to as U S Patent 5,296, 325.

With regard to the 35 USC 132 rejection, the amendment to the specification complies with the Examiner's position that Applicant delete the amendatory language that "the content of Mn as being determined by ICP-OES."

Nonetheless, it bears noting that the Mn content can in fact be determined by both ICP-OES and by atomic absorption spectroscopy. At any rate, the amendment overcomes the 35 USC 132 rejection.

With regard to the 35 USC 102(b) rejections, Applicant submits that the record does not support a *prima facie* case of unpatentability because it fails to establish that the references explicitly or implicitly disclose substantially the same elements in the manner disclosed by the claims. Applicant establishes more fully hereunder the patentable distinction of the claims by presenting a summary of the invention, a statement of the rejection, and arguments as why the prior art fails to teach the claimed invention.

The invention encompasses a toner comprising low-silicon magnetite, wherein the low-silicon magnetite has a silicon content of less than 0.025 wt% based on the weight of the magnetite.

The rejection over Okano is based on the grounds that:

"Okano discloses granular magnetite particles having a specific percentage of aluminum in the mineral's lattice but no silicon is present in the preparation of the magnetite (see Examples 1-23). Because no silicone is disclosed as or in a magnetite reactant, it appears that the amount of silicon inherently would be extremely small, such as a trace amount, which would fall

Mo-6419

within the scope of the instant claims' "low-silicon magnetite." As such the magnetite appears to inherently fall within the scope of the claimed magnetite. Okano discloses this magnetite for use in magnetic toners (col. 1, 1. 11-15)". (Delineation is Applicant's).

The rejection over Taya is based on similar grounds, which are as follows:

"...Taya discloses a magnetite for a magnetic toner that is formed without any silicon-containing reactants (see col. 8, l. 29-52 & the Examples). Because no silicone is disclosed as or in a magnetite reactant, it appears that the amount of silicon inherently would be extremely small, such as a trace amount, which would fall within the scope of the instant claims' "low-silicon magnetite". As such, the magnetite appears to inherently fall within the scope of the claimed magnetite. (Delineation is Applicant's).

Applicant traverses the rejection because the record fails to establish evidence or practical reason of record supporting what is seemingly a rejection based on inherency.

Hence, the issue is whether there is a basis for the 35 USC 102(b) rejection based on inherency, where the record lacks evidence showing that referenced magnetite would necessarily have a silicon content of less than 0.025 wt% based on the weight of the magnetite, as recited by the claims.

It is well settled in the law that the fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic, In re Rijckaert 28 USPQ2d 1955, 1957 (Fed. Cir 1993). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by the person of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient, In re Oelrich 212 USPQ 323, 326 (CCPA 1981).

In this case, the Examiner correctly stated that the referenced magnetite contains no silicon. Yet the Examiner concluded, without facts or technical reasoning, that the referenced magnetite would still contain silicon.

More specifically, the record is devoid of evidence or practical reason of record supporting the conclusion that the referenced magnetite would have a silicon content of less than 0.025 wt% based on the weight of the magnetite, as recited by the claims.

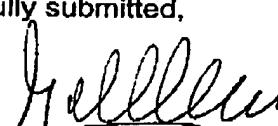
Applicant, for his part, is unaware of facts or technical reason which would have led the skilled artisan to conclude that the referenced magnetite would have a silicon content of less than 0.025 wt% based on the weight of the magnetite as recited by the claim.

In the absence of such factual evidence or technical reason of record, the Examiner's conclusion would not support a *prima facie* case of anticipation. As such, Applicant prays for the withdrawal of the anticipation rejection.

In view of the above amendments and remarks, Applicant submits that the claims in the application are patentably distinct and pray for their allowance.

Respectfully submitted,

By _____


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Mo-6419

- 5 -